UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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RAFAEL SERRANO,

Plaintiff,

14 Civ. 560

-against-

OPINION

JESSICA LOPEZ,

Defendant.

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A P P E A R A N C E S:

Attorneys for Plaintiff

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Sweet, D.J.

The defendant, pro se, Jessica Lopez ("Lopez" or the "Defendant") has moved (1) to dismiss the complaint of plaintiff Rafael Serrano ("Serrano" or the "Plaintiff"), (2) for the appointment of counsel, and (3) for injunctive relief. Serrano has moved to dismiss the counterclaim of Lopez alleging slander.

Based on the conclusions set forth below, the motions of Lopez to dismiss the complaint, for counsel, and for injunctive relief are each denied, and the motion of Serrano to dismiss the slander counterclaim is granted with leave granted to Lopez to replead.

PRIOR PROCEEDINGS

On January 29, 2014, Serrano filed his complaint alleging Defendant's infringement of his intellectual property rights, fraudulent procurement of a federal trademark registration, and misappropriation of his identity and persona. On February 20, 2014, Lopez filed a counterclaim seeking to assert a state law claim for slander and a motion to dismiss Serrano's complaint. Lopez's pleadings also indicated that she sought injunctive relief. On March 17, 2014, Serrano moved to

dismiss Lopez's slander counterclaim. All motions were marked fully submitted on April 16, 2014.

FACTS

1. Plaintiff's Conception and Use of the AMORETTO Mark

Plaintiff's complaint alleges that in or about February of 1985, Serrano conceived of a music performance concept which consisted of group performance combining instrumental and vocal aspects resulting in a musical blend which incorporated versified, traditional elements of Latin music, such as Latin beats and the distinctive clave rhythm, with computerized music sounds. (Compl. ¶ 14.) Visually and in live performance, the music performance concept included an element of dance and physical movement, primarily by two or three female performers who would also provide backup vocals, and further included attire derived from Latin American and Spanish origins of fashion, including black and/or white color-schemed garments and Bolero-styled hats. (Compl. ¶ 15.) The term "AMORETTO" was used by Serrano to identify and promote the distribution and performance of recorded and live music associated with this music performance concept. (Compl. ¶ 13.)

Serrano first made commercial use of the AMORETTO mark when he produced the recorded music album Cláve Rocks on a microgroove vinyl record ("LP record") medium and included three versions of the "Cláve Rocks" song—the Club Vocal, Radio Edit, and Dub Rocks versions. (Compl. ¶ 16.) The production and recording of the AMORETTO Cláve Rocks album was proposed, organized, controlled, and overseen by Serrano. (Compl. ¶ 17.) Serrano exercised creative control and direction over the production of the album and made key personnel decisions surrounding the recording and production of the album, including through composing the various instrumental and vocal roles, and then selecting the specific individuals who would fulfill each role. (Compl. ¶ 18.)

The AMORETTO Cláve Rocks album was recorded and produced on an LP record between February of 1985 and February of 1986 and was sold and distributed beginning in March or April of 1986 with the help of record company PKO Records ("PKO"). (Compl. ¶ 19.) The AMORETTO mark was printed on the labels of the LP record and the record was distributed to a variety of retail outlets for sale to the public and was played on New York-based radio stations broadcasting in the tri-state metropolitan area. (Compl. ¶¶ 19-21.) When the "Cláve Rocks" song was performed on the radio, disc jockeys simultaneously

identified the song with its title (i.e., "Cláve Rocks") and the associated AMORETTO mark. (Compl. ¶ 22.)

In July of 1986, Serrano and PKO created a design for an outer cardboard record jacket to be used for future sales of the Cláve Rocks LP record previously released in March or April of 1986.[1] (Compl. ¶ 23.) The face of the jacket for the AMORETTO Cláve Rocks album prominently featured the album title, Cláve Rocks, alongside the AMORETTO mark. (Compl. ¶ 24.) Serrano and PKO enlisted three women, including Defendant, to pose with Serrano to create the photograph for the AMORETTO Cláve Rocks album cover. (Compl. ¶ 26.) The design for the face of the jacket for the AMORETTO Cláve Rocks album was subject to Serrano's final approval; Serrano alleges Lopez was not involved in the creation, recording, production, or release of the Cláve Rocks album. (Compl. ¶¶ 25, 27.)

In September or October of 1986, Serrano began public performance of the "Cláve Rocks" song using the AMORETTO mark in various locations in New York City and New Jersey. (Compl. ¶¶

[1] Plaintiff notes in his complaint that at the time the album was released, it was common practice among small record companies in the recording industry to undertake designing a record jacket only when an album's initial release had proven to be popular and that this practice accounts for the design of a record jacket for the Cláve Rocks album only after it had proven successful. (Compl. ¶ 23.)

28-29.) Serrano made the booking arrangements and exercised control over the logistics of these early live performance appearances. (Compl. ¶ 30.) During the performances, Serrano danced and played synthesizer and keyboard instruments, while a pre-recorded overlay of the vocal and instrumental tracks from the AMORETTO Cláve Rocks album played. (Compl. ¶ 28.) Three women danced and provided backup vocal accompaniment, attired in Latin American and Spanish fashion-inspired garments - usually in black and/or white color-schemed attire - and topped with Bolero-styled hats. Id.

Lopez was one of the three female dancers and backup vocalists who initially performed with Serrano under the AMORETTO mark. (Compl. ¶ 31.) After several months, however, Serrano became unsatisfied with Lopez' performance quality and level of dedication to his performance concept and Serrano replaced Lopez with another female dancer and singer. Id.

During 1986 and 1987 Serrano continued to promote the concept and expanded his recorded and live music performance activities under the AMORETTO mark to a variety of venues, including Miami, Puerto Rico, South America, the Dominican Republic, and Germany. (Compl. ¶¶ 32-33.) The live performances continued to feature Serrano dancing and playing

synthesizer and keyboard instruments, while a pre-recorded overlay of the vocal and instrumental tracks from the AMORETTO Cláve Rocks album played. (Compl. ¶ 34.) Three women danced and provided backup vocal accompaniment, attired in Latin American and Spanish fashion-inspired garments - usually in black and/or white color-schemed attire - and topped with Bolero-style hats. Id.

Between 1987 and about 1995, Serrano recruited approximately twelve different dancers and backup singers to act in live performances of Serrano's distinctive music concept under the AMORETTO mark. (Compl. ¶ 35) Serrano actively promoted the AMORETTO mark, appearing on Puerto Rican television and performing with other well-known artists. (Compl. ¶¶ 36-37.) At all times Serrano exercised creative control, quality oversight, personnel selection, and decision-making over the performance activities under the AMORETTO mark. (Compl. ¶ 35.)

To this day, Serrano has continued to use the AMORETTO mark to promote his work. (Compl. ¶ 41). Serrano receives royalty payments for the authorized playback, sale, and performance of the AMORETTO "Cláve Rocks" song and he continues to promote his concept under the AMORETTO mark to consumers through popular distribution and communication channels such as

YouTube, Discogs, and Facebook. (Compl. ¶¶ 42, 44.) Serrano's efforts and commercial activities using the AMORETTO mark have resulted in consumers' recognition and association of the AMORETTO name with Serrano and his distinctive music concept. (Compl. ¶ 39.)

2. Defendant's Use of the AMORETTO Mark

Lopez has used the AMORETTO name in commerce in connection with recorded music and live music performance. (Compl. ¶ 45.) Her recorded music works under the name AMORETTO have been and continue to be available for purchase by the consuming public. (Compl. ¶ 46.) Lopez has also performed under the name AMORETTO at venues in New York City and in the New York City metropolitan area. (Compl. ¶ 48.) Both Lopez' recorded music and performances under the AMORETTO mark have incorporated structural and stylistic music features similar to those employed by Serrano. (Compl. ¶ 49.)

Additionally, Lopez has performed songs with similar titles and content to those performed and recorded by Serrano, such as songs titled "Rock the Clave" and "Clave Rock," under the AMORETTO name. (Compl. ¶ 52.) Lopez has also featured elements of dance and physical movement implemented through the

inclusion of two or three female performers who provide backup vocal support along with dance contributions and who appear, in the style of their dance, physical movement, and performance attire in a manner similar to the visual performance aspects of the AMORETTO-brand music concept. (Compl. ¶¶ 55-56.) In at least one public performance in New York City under the name AMORETTO, Lopez has featured a male performance role in which the male performer resembles Serrano. (Compl. ¶ 59.) Music fans, after viewing Lopez' performances under the AMORETTO name, have contacted Serrano to question whether there is any relationship between Serrano and Lopez' music activities. (Compl. ¶ 62.)

Serrano has more than once apprised Lopez of his rights in the AMORETTO mark and Serrano's counsel has requested that Lopez cease and desist her use of the AMORETTO mark. (Compl. ¶ 63.)

3. Defendant's Procurement of USPTO Registration for the AMORETTO Mark

On November 3, 2010, Lopez filed a Trademark/Service Mark Application, Serial Number 85/168,554 (the "'554 application"), with the United States Patent and Trademark

Office (the "USPTO") seeking federal registration for the mark AMORETTO for "[s]ound recordings featuring music" and "[e]ntertainment, namely, live music concerts; [e]ntertainment, namely live performances by a musical band." (Compl. ¶¶ 64-65.) In the application, Lopez declared that she "believes the applicant to be the owner of the trademark/service mark sought to be registered," and further declared that "to the best of [her] knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce." (Compl. ¶ 67.) Lopez also submitted to the USPTO a photograph of the AMORETTO Cláve Rocks album and represented that it was a "photographed album cover with picture of AMORETTO performing live musical concert with her band on cover." (Compl. ¶ 73.)

At the time Lopez submitted her application, Serrano had already expressly apprised Lopez of his rights in the AMORETTO mark. (Compl. ¶ 69.)

On March 15, 2011, the USPTO examiner rejected the '554 application in its entirety. With respect to Lopez' request to register the mark for "[s]ound recordings featuring music," the USPTO examiner stated that the specimen of record (i.e., the photograph of the face of the jacket of the AMORETTO Cláve Rocks album) was insufficient alone to demonstrate use of

the AMORETTO name as a mark. (Compl. ¶ 80.) The USPTO examiner required that Lopez supplement the '554 application with (a) one or more additional specimen(s) demonstrating that the AMORETTO name was used by the applicant on a series of sound recordings and (b) evidence that the AMORETTO name was promoted and recognized by others as the source of the series of sound recordings, or evidence that the performer controlled the quality of the recordings and controlled the use of the name. Id. The USPTO examiner further explained that if the sound recordings were recorded under the applicant's control, Lopez could submit, as evidence of control, a sworn statement that "[t]he applicant produces the goods and controls their quality." Id.

On June 29, 2011, Lopez submitted an additional specimen in the form of a photograph of Lopez holding two LP record jackets, one of which was the AMORETTO Cláve Rocks album, and the other an album released by the artist DIVA titled I Wanna Break Night With You. (Compl. ¶ 81.) Lopez' specimen displayed the jacket of DIVA's I Wanna Break Night With You with the word "Amoretto," while the commercially-released album jacket does not contain the word "Amoretto." (Compl. ¶ 82.) Along with the specimen, Lopez also submitted an explanatory statement to the USPTO representing that this specimen was a

"digitally photographed picture of AMORETTO holding two compact disc covers displaying discography of AMORETTO as supporting evidence that the applied-for-mark is used as a series of multiple works and not a single work." (Compl. ¶ 84.) Lopez noted that "[i]n response to the substantive refusal(s) . . . [t]he applicant produces the goods and controls their quality." (Compl. ¶ 90.)

Lopez is not named on the DIVA I Wanna Break Night With You album credits. (Compl. ¶ 88.)

On November 1, 2011, the USPTO granted the '554 application and Lopez was issued U.S. trademark registration No. 4,048,043 (the "'043 registration"). (Compl. ¶ 95.) Subsequently, Lopez has demanded, citing the '043 registration, that Serrano cease and desist from the use of the trade name and service mark AMORETTO. (Compl. ¶ 97.) Lopez has also submitted infringement complaints to YouTube, requesting that YouTube remove videos depicting performances by Serrano under the AMORETTO mark. (Compl. ¶ 98.) YouTube has honored this request on at least one occasion. Id.

Serrano has faced reluctance from prospective business partners to collaborate and invest in business ventures to

further develop and capitalize on the AMORETTO-brand music concept. (Compl. ¶ 99.) Lopez' registration for the AMORETTO mark has been given as the reason for this reluctance. Id.

4. Allegations of Defamation

Lopez claims that Serrano has defamed her "on the internet[,] by phone to [her] colleagues and by email and at venues" over the past 29 years and more frequently since July 6, 2013. (Countercl. 9.) She further states that Serrano "tells everyone that [she] is riding his 'coat tail.'" Id. Lopez alleges that she has sustained mental, emotional and financial injuries, such as money she would get from performing shows, and that she has been in "Doctor's care for fear and depression" as a result of Serrano's actions. (Countercl. 9-10.)

DISCUSSION

1. Defendant's Motion to Dismiss Does Not Set Forth a Cognizable Basis for Dismissal

On a motion to dismiss pursuant to Rule 12(b)(6), all factual allegations in the complaint are accepted as true, and all inferences are drawn in favor of the pleader. Mills v. Polar Molecular Corp., 12 F.3d 1170, 1174 (2d Cir. 1993). A

complaint must contain "sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" Ashcroft v. Iqbal, 556 U.S. 662, 663 (2009) (quoting Bell Atl. Corp. v. Twombly, 550 U.S. 544, 570 (2007)). "A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged." Desilva v. North Shore-Long Island Jewish Health Sys., Inc., 770 F.Supp.2d 497, 506 (E.D.N.Y. 2011) (citing to Twombly, 550 U.S. at 555 ("[A] plaintiff's obligation to provide the grounds of his entitlement to relief requires more than labels and conclusions, and a formulaic recitation of the elements of a cause of action will not do.")). In other words, the factual allegations must "possess enough heft to show that the pleader is entitled to relief." Twombly, 550 U.S. at 557 (internal quotation marks omitted).

Plaintiff provides a lengthy and detailed description of events relating to Lopez in his complaint. (Compl. ¶¶ 13-100.) Lopez has denied the allegations of the complaint but has failed to set forth a cognizable basis to dismiss the complaint.[2] As such, her motion to dismiss must be denied.

[2] Liberally construed, Lopez's papers could be read to allege that the complaint is, in some sense, time-barred. (Def. Aff. 1) ("Serrano had one

2. Defendant May Seek Counsel Through the Pro Se Office

Lopez may seek appointment of counsel through the Pro Se Office of the court. Her motion for court appointment is denied at this time with leave granted to renew at the time of any dispositive action.

3. Defendant Has Failed to Make a Factual Showing Justifying Injunctive Relief

In order to establish a claim for preliminary injunctive relief, a movant must show: "(1) irreparable harm and (2) either (a) a likelihood of success on the merits, or (b) sufficiently serious questions going to the merits of its claims to make them fair ground for litigation, plus a balance of the hardships tipping decidedly in favor of the moving party." Citigroup Global Markets, Inc. v. VCG Special Opportunities Master Fund Ltd., 598 F.3d 30, 35 (2d Cir. 2010); see also Oneida Nation of N.Y. v. Cuomo, 645 F.3d 154, 164 (2d Cir. 2011). The moving party must not only show that there are "serious questions" going to the merits, but must also establish

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year to contest me - now 3-5 YRS later - he's contesting me?") Lopez has only made one remark to this effect, however, and has failed to clarify any sufficiently clear statute of limitations grounds that can be treated as a cognizable grounds for dismissal.

that "the balance of hardships tips decidedly" in its favor. Citigroup Global Markets, Inc., 598 F.3d at 35 (quoting Jackson Dairy, Inc. v. H.P. Hood & Sons, Inc., 596 F.2d 70, 72 (2d Cir. 1979)).

In order for injury to be considered irreparable it must be "actual and imminent" and one that "cannot be remedied if a court waits until the end of trial to resolve the harm." Toney-Dick v. Doar, No. 12-9162, 2013 WL 1314954, at *9 (S.D.N.Y. Mar. 18, 2013) (quoting Faiveley Transp. Malmo AB v. Wabtec Corp., 559 F.3d 110, 118 (2d Cir. 2009)). Money damages are thought to be the "antithesis of irreparable harm." Toney-Dick, 2013 WL 1314954, at *9; see also Synergy Advanced Pharm., Inc. v. CapeBio, LLC, No. 10-1736, 2010 WL 2194809, at *4 (S.D.N.Y. June 1, 2010). To make a showing of a "likelihood of success" a plaintiff must convince the Court that it is more likely than not - or "the probability of prevailing is 'better than fifty percent'" - that it will succeed on its claims. Greenlight Capital, L.P. v. Apple, Inc., No. 13-976, 2013 WL 646547, at *4 (S.D.N.Y. Feb. 22, 2013) (quoting BigStar Entm't, Inc. v. Next Big Star, Inc., 105 F.Supp.2d 185, 191 (S.D.N.Y. 2000)).

To the extent that Lopez seeks injunctive relief, she has made no showing, factual or otherwise, in support of her request for this remedy and, as such, it must be denied.[3] See, e.g., A.X.M.S. Corp. v. Friedman, 948 F.Supp.2d 319 (S.D.N.Y. 2013) (request denied where movant made insufficient showing under the applicable factors).

4. Defendant's Counterclaim Contains Insufficient Factual Matter to Survive a Motion to Dismiss

Defamation is the injury to one's reputation either by written expression, which is libel, or by oral expression, which is slander. Krepps v. Reiner, 588 F.Supp.2d 471, 483 (S.D.N.Y. 2008) aff'd, 377 F. App'x 65 (2d Cir. 2010) (citing Idema v. Wager, 120 F.Supp.2d 361, 365 (S.D.N.Y. 2000)). To state a claim for defamation, a plaintiff "must allege (1) a false statement about the plaintiff, (2) published to a third party without authorization or privilege, (3) through fault amounting to at least negligence on [the] part of the publisher, (4) that either constitutes defamation per se or caused 'special

[3] Indeed, Lopez seems to allege that she is suffering monetary damages, which are an improper basis for granting a preliminary injunction. (Countercl. 10) ("I am seeking that he stop harassing me – honor the court order set by a Judge in his own home town in New Jersey to stop contacting people I work with including record label and friends to get those people to stop working with me. Each day he does this I loose [sic] show money."); Toney-Dick, 2013 WL 1314954, at *9 (if the "harm can be remedied in money damages[, that] is the antithesis of irreparable harm, and such a fact requires that the Court not find an irreparable injury").

damages.'" Thai v. Cayre Group, Ltd., 726 F.Supp.2d 323, 329 (S.D.N.Y. 2010).

A defamation or slander claim "is only sufficient if it adequately identifies the purported communication, and an indication of who made the communication, when it was made, and to whom it was communicated." Thai, F.Supp.2d at 329 (quoting Scholastic, Inc. v. Stouffer, 124 F.Supp.2d 836, 849 (S.D.N.Y. 2000)). A complaint that sufficiently alleges the occurrence of a false statement of fact must nevertheless be dismissed if it fails to also allege "who," "when," and "to whom" the alleged defamatory statements were made. Reeves v. Cont'l Equities Corp. of Am., 767 F.Supp. 469, 473 (S.D.N.Y. 1991); see also Krepps, 588 F.Supp.2d at 484 (noting that failure to identify allegedly defamatory and slanderous statements were too generalized and, as such, insufficient to state a claim); see also, Nowak v. EGW Home Care, Inc., 82 F.Supp.2d 101, 113 (W.D.N.Y. 2000).

This court construes Lopez's counterclaim allegations liberally. Erickson v. Pardus, 551 U.S. 89, 94 (2007) ("[A] pro se complaint, however inartfully pleaded, must be held to less stringent standards than formal pleadings drafted by lawyers.") (quoting Estelle v. Gamble, 429 U.S. 97, 106 (1976)).

Nevertheless, although Lopez alludes to ongoing, repeated instances of alleged defamation, her counterclaim lacks the requisite specificity to survive a motion to dismiss. See Iqbal, 556 U.S. at 678 (though the court must accept the factual allegations of a complaint as true, it is "not bound to accept as true a legal conclusion couched as a factual allegation") (quoting Twombly, 550 U.S. at 555). At most, Lopez alleges a vague statement made by the Plaintiff that Lopez was "riding his 'coat tail.'" (Countercl. 9.) This type of statement, however, is most appropriately categorized - to the extent it can be analyzed without proper factual context and specificity - as a statement of opinion, which is not actionable as defamation. See Biro v. Condé Nast, 883 F.Supp.2d 441, 459-60 (S.D.N.Y. 2012); Egiazaryan v. Zalmayev, 880 F.Supp.2d 494, 503 (S.D.N.Y. 2012). Lopez's counterclaim for defamation, therefore, is dismissed with leave granted to replead within 20 days.

CONCLUSION

Based upon the facts and conclusions of law set forth above, the Defendant's motions to dismiss the complaint, for the appointment of counsel, and for injunctive relief are denied. Plaintiff's motion to dismiss the slander counterclaim is granted. Defendant is granted leave to replead within 20 days.

Dated: New York, New York
June 18, 2014

Robert W. Sweet, U.S.D.J.